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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,927	10/10/2000	Hideki Usuki	DAIN: 563	2321

7590 04/14/2003

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EXAMINER	
XU, LING X	

ART UNIT	PAPER NUMBER
1775	

DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-13

Advisory Action	Application No. 09/684,927	Applicant(s) USUKI ET AL.	
	Examiner Ling X. Xu	Art Unit 1775	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a] or b]]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on *25 March 2003*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attached*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1 and 4-9*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☒ Other: *No amendment was filed after Final Rejection.*

DEBORAH JONES
SUPERVISORY PATENT EXAMINER

DETAILED ACTION

The request for reconsideration has been considered but does not place the application in condition for allowance because:

1. Applicants argue "the second sentence in the third paragraph of the Response to Argument is classic hindsight and shows the use of applicants' specification, the applicants' discovery, to justify the rejection. There is nothing in either reference that shows the specific controls on the amount of microsilica and the coefficients of friction recited in the claims".

The Examiner disagrees. The first three sentences in the third paragraph of the Response to Argument read as follows:

> "As stated above, the combination of Oshima and Kanto teaches incorporating microsilica in the range of 0.01 to 10%, which includes the claimed range of 0.3-10%, in the adhesive layer can reduce the coefficient of friction of the surface of the adhesive layer."

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As stated in the prior Office action, Kanto clear teaches by incorporating fine particles into the adhesive layer can reduce the coefficient of friction of its surface (Col. 6, lines 10-20). Examples of fine particles are silica (microsilica, because the thickness of the adhesive layer is on the order of a few μm, see col. 3, lines 40-45). Kanto also teaches that the addition of such inorganic fine particles in the range of 0.01 to 10% by weight makes it possible to reduce the coefficient of friction of the surface of the adhesive layer (Col 4, lines 12-20).

Accordingly, the obviousness rejection is not based on the applicants' specification and discovery, but based on Kanto's teaching. As also stated in the Final Office action, the combination of Oshima and Kanto teaches incorporating microsilica in the range of 0.01 to 10%, which includes the claimed range of 0.3-10%, in the adhesive layer. Accordingly, the adhesive layer added microsilica in the range of 0.01 to 10% as taught by Oshima and Kanto will also have the same properties as claimed, such as the coefficient of friction values.

2. Applicants also argue that the first and second paragraphs on page 5 of the final Rejection show classic hindsight because Kanto et al. '112 provides not proper rationale to increase the microsilica content in the adhesive layer of Oshima et al. '997. The working and comparative examples, establish why one should not use less than 3%

(note: the Examiner presume it should be less than 0.3%) of microsilica, a matter neither taught nor suggested in either reference.

The Examiner disagrees. The first three sentences on page 5 of the Final Rejection read as follows:

> "Applicants also argue that Oshima shows that an adhesive containing 0.8% of microsilica, therefore, the advantages to be gained by using relatively larger quantities of microsilica are not taught or suggested. The Applicants also argue the second reference, Kanto, lacks any teaching regarding the use of an adhesive layer to maintain a coefficient of friction between the surface of the protective layer and the surface of an image-receiving sheet before thermal transfer as claimed.
>
> In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As stated above, the combination of Oshima and Kanto teaches incorporating microsilica in the range of 0.01 to 10%, which includes the claimed range of 0.3-10%, in the adhesive layer can reduce the coefficient of friction of the surface of the adhesive layer."

As stated above, Kanto clear teaches by incorporating fine particles into the adhesive layer can reduce the coefficient of friction of its surface and the amount of

using the fine particles in the range of 0.01 to 10% by weight makes it possible to reduce the coefficient of friction of the surface of the adhesive layer (Col 4, lines 12-20).

Accordingly, the rejection is not based on the applicants' specification and the applicants' discovery, but based on Kanto's teaching. Although Kanto teaches the range including the use of microsilica in the range of less than 0.3%, Kanto teaches the range including the claimed 0.3-10%. Kanto teach the present invention.

3. With respect to the argument related to the last paragraph on Page 5 of the Final Rejection:

> "The cited working and comparative examples in the specification and the results appearing in Table 1 at page 22 (the Examiner's note: should be Table 1 at page 21) and in Table 2 at page 23 also support that the values of the coefficient of friction as claimed are the direct result of having microsilica in the range of 0.3-10% in the adhesive layer."

Applicants argue that the working examples clearly show results significantly better than those shown in the three comparative examples. The three comparative examples include the use of filler in an amount less or more than the claimed range. However, since Kanto teaches the use of the filler including the claimed range, Kanto teaches the invention.

With respect to the argument related to "the values of the coefficient of friction as claimed are the direct result of having microsilica in the range of 0.3-10% in the adhesive layer", applicants argue that "evidence in support of patentaility clearly exists

in this case and cannot be dismissed as merely the "direct result" of practicing the claimed invention".

The Examiner disagrees. The values of the coefficient of friction as claimed are the property of the adhesive layer having microsilica in the range of 0.3-10% in the present application.

As stated in the Final Office action, the combination of Oshima and Kanto teaches incorporating microsilica in the range of 0.01 to 10%, which includes the claimed range of 0.3-10%, in the adhesive layer. Accordingly, the adhesive layer added microsilica in the range of 0.01 to 10% as taught by Oshima and Kanto will also have the same properties as claimed, such as the coefficient of friction values.

Ling X. Xu
Examiner
Art Unit 1775

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April 11, 2003